UNITED STATES PATENT AND TRADEMARK OFFICE

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09/675,252	09/29/2000	Satoshi Washizuka	1035-283	1246

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EXAMINER
PATEL, JAGDISH

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 September 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>2-17 and 19-27</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>2-17 and 19-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. This communication is in response to amendment filed

   9/8/2004.

Response to Amendment

2. Claims 1 and 18 have been canceled. Claims 2-17 and 19 have

   been amended and new claims 20-27 have been added per

   request.

3. The title of the application has been changed per request.

Response to Arguments

4. Applicant's arguments with respect to claims 1-19 have been

   considered but are moot in view of the new ground(s) of

   rejections.

Claim Rejections - 35 USC § 112

5. Claim 16 is rejected under 35 U.S.C. 112, second paragraph,

   as being indefinite for failing to particularly point out

   and distinctly claim the subject matter which applicant

regards as the invention. Claim 16 is not sufficiently
precise due to the combining of two different statutory
classes of invention in a single claim. The preamble the
claim refers to a method, but the body of the claim
discusses the specifics of the system. The claim recites a
buyer terminal, a reconciliation unit and a seller terminal
as limitation of a system and subsequently the claim then
deals with the specifics of a method steps which are
predicated upon the system limitations such as "creating in
said buyer terminal purchase request data" etc.

6. Claims 6-14 are rendered indefinite because they do not
further limit the system or apparatus of the parent claim.
Example: claim 6 describes the reconciliation unit without
reciting any structural element of the reconciliation unit,
which would further limit the reconciliation unit and which
performs the act recited the claim. Therefore, claims 6-9
are treated as non-functional descriptive material. To
correct this deficiency the claims must show structural
elements of the reconciliation unit, which carry out these
acts or functions.

7. Similarly claims 10-14 contain the following deficiencies.

As an example, Claim 10 further limits the seller terminal as
including an input device. However, it also describes the
functions performed by the seller terminal without reciting any
structural elements (e.g. means for ..). Claims 11-14 contain
similar deficiencies.

Based on the foregoing analysis claims 6-14 are analyzed as
being indefinite and failing to particularly point out and
distinctly claim the subject matter which applicant regards as
the invention.

Claim Rejections - 35 USC § 101

8. Claim 16 is rejected under 35 U.S.C. §101 because the
   claimed invention is directed to a non statutory subject
   matter.

35 U.S.C. §101 requires that in order to be patentable the
invention must be a **"new and useful process, machine,
manufacture or composition of matter or new and useful
improvement thereof"** (emphasis added). Applicant's claims
mentioned above are intended to embrace or overlap two

different statutory classes of invention as set forth in 35

U.S.C. §101. The claim begins by discussing a method (ex.

Preamble of claim 16), the body of the claim discusses the

specifics of the system and method ((see 112(second)

rejection)). (see rejection of claims under 35 U.S.C. §112,

second paragraph, for specific details regarding this issue).

"a claim of this type is precluded by express language of 35

U.S.C. §101 which is drafted so as to set forth statutory the

statutory classes of invention in the alternative only", Ex

parte Lyell (17USPQ2d 1548).

Claim Rejections- 102

A person shall be entitled to a patent unless--

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States

Claims 2-15, 17, 19, 20, and 22-27 are rejected under 35

U.S.C. 102(b) as being clearly anticipated by Walker et al. (US

5,794,207) (Walker).

Claim 17 Walker-207 discloses an account reconciliation

server (central controller 200, see Fig. 1 and 2), which

guarantees account reconciliation in purchase transactions

between a buyer and a seller of a product or service ,

said account reconciliation server comprising:

a communicating circuit means for establishing

communications with each of a buyer terminal of the buyer and a

seller terminal of the seller;

(Fig. 1 network interface 245)

credit data creating means for creating, based on purchase

request data received from the buyer terminal, credit data

including information which specifies purchase transaction

conditions for the product or service, and sending the credit

data created to said seller terminal, said credit data

guaranteeing account reconciliation for the product or service;

(CPU 205 and payment processor 230 connected to data

storage device 250, see at least Fig. 2 and col. 12 L 35-46)

delivery list creating means for creating and sending to

said buyer terminal delivery list data relating to delivery of

the product or service when the product or service is received

from the seller;

(see at least Fig. 2 purchase confirmation database 275.

and col. 13 L 39-43. Purchase confirmation database 275 tracks

the messages sent to the buyer and seller confirming completed

transactions (bound contracts). Fields include buyer name, buyer

ID number, seller name, seller ID number, purchase confirmation

tracking number, and associated CPO tracking number.)

claiming means which, when   acceptance data for the

delivery list data is received from the buyer terminal, causes

the ' the product or service to be delivered to the buyer, and

sends a claim to the buyer for payment for the product or

service.

(see at least col. 17 L 27-47 .. at step 610, payment

processor 230 submits a pre-authorization of the price of CPO

100 to the credit card clearinghouse.)

Claim 19:   An account reconciliation server which

guarantees account reconciliation in a purchase transaction

between a buyer and a seller of a product or service,

said account reconciliation server comprising:

a communicating circuit means for establishing

communications with each of a buyer terminal for the buyer

and a seller terminal for the seller;

(see claim 17 analysis)

credit data creating means for creating, based on purchase

request data for the product or service supplied from the buyer

terminal credit data including information which specifies

purchase transaction conditions for the product or service , and

sending the credit data to said seller terminal means, said

credit data guaranteeing payment to the seller for the supplying

of the product or service; (see at least col. 17 L 27-47 .. at

step 610, payment processor 230 submits a pre-authorization of

the price of CPO 100 to the credit card clearinghouse.)

and

claiming means for, when acknowledgement data is received

via said seller terminal, sending payment data to said seller

terminal for the product or service, while billing the buyer for

the payment for the product or service , said acknowledgement

data being issued by said buyer terminal when the buyer

receives from the seller the product or service   which is

based on content of the credit data and when the content

satisfies the purchase transaction conditions in the credit

data.

(col. 9 L 31-44 Escrow account 299 allows payment to be

delayed until the seller completes delivery of the goods, while

at the same time ensuring that the buyer will in fact make

payment. Central controller 200 establishes escrow account 299

as a temporary holding account. When the seller binds CPO 100 at

step 1110, funds are transferred from buyer account 297 to

escrow account 299. Only after the goods have been received by

the buyer are funds transferred from escrow account 299 to

seller account 298.)

Claim 20: An accounting and reconciliation system

comprising:

a seller terminal for a seller, the seller terminal

receiving credit data guaranteeing payment for a product or

service, and receiving payment data for the product or service;

(Fig. 3 seller interface 300, modem 350)

a buyer terminal for a buyer, the buyer terminal sending

purchase request data including purchase transaction information

which specifies purchase transaction conditions for the product

or service;

(Fig. 4 buyer interface 400, modem 450)

a reconciliation unit for mediating a purchase transaction

between the buyer and the seller in response to receiving the

purchase request data sent from the buyer terminal, (see Fig. 2

central controller) the reconciliation unit comprising:

communication circuitry for communicating with the buyer

terminal and the seller terminal;

(network interface 245) and

a processing system responsive to the purchase request data

for sending the credit data to the seller terminal, and for

sending the payment data to the seller terminal after receiving

acknowledgment data indicative of the buyer's acknowledgment of

receipt of the product or service.

(Figures 2 and 6, col. 9 L 32-44, see col. 22 `delayed

payment embodiments)

Claim 2: The accounting and reconciliation system as set

forth in claim 20, wherein:

said seller terminal includes an input device

usable by the seller to input an estimate in response to an

estimate request from the buyer for a product or service to be

supplied,

(see Fig. 3 input device 345 see also corresponding

description)

said seller terminal creates estimate data based on the

estimate and sends the estimate data to said buyer terminal, and

(col. 19 L 55-59)

said buyer terminal receives the estimate data and creates

the purchase request data based on the received estimate data.

(col. 19 L 55-59)

Claim 3: The accounting and reconciliation system as set forth in claim 2 wherein:

said buyer terminal includes a display for displaying content of the received estimate data, and an input device usable the buyer to accept the content of the displayed estimate data, and

said buyer terminal creates the purchase request data upon acceptance of the content of the estimate data.

(col. 19 L 55-59, display device is inherent to the online access by the buyer described at col. 15 L 45+)

Claim 4: The accounting and reconciliation system as set forth in claim 3, wherein:

the estimate data contains information which specifies first and second payment methods, and

said buyer terminal prompts the buyer via said display to confirm that the second payment method may be used if the first payment method fails.

Claim 5: The accounting and reconciliation system as set forth in claim 20, wherein:

said buyer terminal includes an input device usable by the buyer to input information which relates to one or more of an

effective period of the purchase request data, delivery date of

the product or service services, delivery method of the product

or service, possibility of separate delivery, and due date of

payment from a bank, and

    said buyer terminal incorporates the input information in

the purchase request data.

    (col. 17 L 36-41, col. 16 L 46 "expiration date" to the

CPO)

    Claim 15: The accounting and reconciliation system

wherein the buyer terminal comprises a cellular phone.

    (see col. 11 L 61+ Connection may also be provided by

dedicated data lines, *cellular,* Personal Communication Systems

("PCS"), microwave, or satellite networks)

    Claim 21: Walker discloses an accounting and reconciliation

system comprising:

    a seller terminal for a seller, the seller terminal

receiving credit data guaranteeing payment for a product or

service, and receiving payment data for the product or service;

    (Figure 3 seller interface, and Figures 9 and 11)

    a buyer terminal for a buyer, the buyer terminal sending

purchase request data including purchase transaction information

which specifies purchase transaction conditions for the product

or service, receiving delivery list data relating to delivery of

the product or service, and sending acceptance data in response

to the delivery list data;

(Figure 4 Buyer interface, Figures 5 and 13)

and

a reconciliation unit for mediating a purchase transaction

between the buyer and the seller in response to receiving the

purchase request data sent from the buyer terminal to the

reconciliation unit, the reconciliation unit comprising:

communication circuitry for communicating with the buyer

terminal and the seller terminal;

(Fig. 2, central controller 200, and process performed by

the central controller as shown in Figures 6-8, refer also to

the appropriate sections of the Detailed Description)

a processing system responsive to the purchase request data

for sending the credit data to the seller terminal and for

sending the payment data to the seller terminal after the

product or service is supplied from the seller.

(Figure 11 and col. 19 L 61- col. 20 L 4)

Claims 22-27 are apparatus claims, which recite structure

of an apparatus (such as claim 22 recites structure of a

reconciliation unit). Examination of the apparatus claims is

based upon and supported by the following guidelines (see

applicable section of MPEP).

Apparatus and Article Claims — Functional Language

For a discussion of case law which provides guidance in

interpreting the functional portion of means-plus-function

limitations see MPEP § 2181 - § 2186.

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE

FROM THE PRIOR ART

While features of an apparatus may be recited either

structurally or functionally, <u>claims directed to an apparatus</u>

<u>must be distinguished from the prior art in terms of structure</u>

<u>rather than function.</u> [In re Schreiber, 128 F.3d 1473, 1477-78,

44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a

disclosure in a prior art reference relating to function did not

defeat the Board's finding of anticipation of claimed apparatus

because the limitations at issue were found to be inherent in

the prior art reference); see also In re Swinehart, 439 F.2d

210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263

F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus

claims cover what a device is, not what a device does." Hewlett-

Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15

USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE

APPARATUS CLAIM FROM THE PRIOR ART

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural imitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.

The following analysis of claims 22-27 is based upon the foregoing examination guidelines for an apparatus.

Per Claim 22 Walker disclose a reconciliation unit [for an accounting and reconciliation system comprising a seller terminal for a seller, the seller terminal receiving credit data guaranteeing payment for a product or service, and receiving payment data for the product or service, and a buyer terminal

for a buyer, the buyer terminal sending purchase request data

containing purchase transaction information which specifies

purchase transaction conditions for the product or service,

wherein the reconciliation unit mediates a purchase transaction

between the buyer and the seller in response to receiving the

purchase request data sent from the buyer terminal,] the

reconciliation unit (see Figure 2, central controller 200)

comprising:

communication circuitry for communicating with the buyer

terminal and the seller terminal; (Figure 2, network interface

245)

and

a processing system responsive to the purchase request data

for sending the credit data to the seller terminal and for

sending the payment data to the seller terminal after receiving

acknowledgment data indicative of the buyer's acknowledgement of

receipt of the product or service.

(Figure 2, CPU 205, payment processor 230 and data

storage device 250 connected to buyer and seller terminals; also

refer to Figure 11 and col. 19 L 60+)

Claim 23: walker discloses a reconciliation unit (see

Figure 2, central controller 200) for an accounting and

reconciliation system comprising a seller terminal for a seller,

the seller terminal receiving credit data guaranteeing payment

for a product or service, and receiving payment data for the

product or service, and a buyer terminal for a buyer, the buyer

terminal sending purchase request data including purchase

transaction information which specifies purchase transaction

conditions for the product or service, receiving delivery list

data relating to delivery of the product or service, and sending

acceptance data in response to the delivery list data, wherein

the reconciliation unit mediates a purchase transaction between

the buyer and the seller in response to receiving the purchase

request data sent from the buyer terminal, the reconciliation

unit comprising:

communication circuitry for communicating with the buyer

terminal and the seller terminal; (Figure 2, network interface

245)

and

a processing system responsive to the purchase request data

for sending the credit data to the seller terminal, and for

sending the payment data to the seller terminal after the

product or service is supplied from the seller.

(Figure 2, CPU 205, payment processor 230 and data storage
device 250 connected to buyer and seller terminals; also refer
to Figure 11 and col. 19 L 60+)

Claim 24: Walker discloses a buyer terminal (see Figure 4, Buyer
interface 400) for a buyer for use in an accounting and
reconciliation system comprising a seller terminal for a seller,
the seller terminal receiving credit data guaranteeing payment
for a product or service, and receiving payment data for the
product or service, and a reconciliation unit for mediating a
purchase transaction between the buyer and the seller in
response to receiving purchase request data, the reconciliation
unit comprising communication circuitry for communicating with
the buyer terminal and the seller terminal, and a processing
system responsive to the purchase request data for sending the
credit data to the seller terminal and for sending the payment
data to the seller terminal after receiving acknowledgment data
indicative of the buyer's acknowledgment of receipt of the
product or service, the buyer terminal comprising:

communication circuitry for communicating with the seller
terminal and the reconciliation unit; (see Fig. 4, communication
port 440 connected to Modem 450)

one or more input devices; (see Fig. 4, input device 445)

a processing system for sending the purchase request data

to the reconciliation unit, the purchase request data including

purchase transaction information which specifies purchase

transaction conditions for the product or service, and for

sending the acknowledgement of receipt of the product or service

to the reconciliation unit in response an input by the buyer

using the one or more input devices.

(central processing unit 405 Fig. 4 which performs purchase

request described in Fig. 5).

Claim 25: A seller terminal for a seller for use in an

accounting and reconciliation system comprising a buyer terminal

for a buyer, the buyer terminal sending purchase request data

including purchase transaction information which specifies

purchase transaction conditions for a product or service, and a

reconciliation unit for mediating a purchase transaction between

the buyer and the seller in response to receiving the purchase

request data sent from the buyer terminal, the reconciliation

unit comprising communication circuitry for communicating with

the buyer terminal and the seller terminal, and a processing

system responsive to the purchase request data for sending

credit data guaranteeing payment for the product or service and

for sending payment data for the product or service after

receiving acknowledgment data indicative of the buyer's

acknowledgement of receipt of the product or service, the seller

terminal comprising:

communication circuitry for communication with the buyer

terminal and the reconciliation unit; and

a processing system for receiving the credit data and the

payment data from the reconciliation unit.

(please refer to claim 27 analysis)

Claim 26: A buyer terminal for a buyer for use in an

accounting and reconciliation system comprising a seller

terminal for a seller, the seller terminal receiving credit

data guaranteeing payment for a product or service, and

receiving payment data for the product or service, and a

reconciliation unit for mediating a purchase transaction between

the buyer and the seller in response to receiving purchase

request data, the reconciliation unit comprising communication

circuitry for communicating with the buyer terminal and the

seller terminal, and a processing system responsive to the

purchase request data for sending the credit data to the

seller terminal and for sending the payment data to the seller

terminal after the product or service is supplied from the

seller, the buyer terminal comprising:

communication circuitry for communicating with the seller

terminal and the reconciliation unit; see Fig. 1, Buyer or

Seller Interface 400 having a communication port 440 shown in

Fig. 4, col. 9 L 18-29, communication links)

one or more input devices; (input device 470)

a processing system [for sending the purchase request data

to the reconciliation unit, the purchase request data including

purchase transaction information which specifies purchase

transaction conditions for the product or service, for receiving

delivery list data relating to delivery of the product or

service, and for sending acceptance data input using the one or

more input devices in response to the delivery list data.]

(central processing unit 408 Fig. 4 and col. 32-42).

Claim 27: <u>A seller terminal</u> [for a seller for use in an

accounting and reconciliation system comprising a buyer terminal

for a buyer, the buyer terminal sending purchase request data

including purchase transaction information which specifies

purchase transaction conditions for the product or service,

receiving delivery list data relating to delivery

of the product or service, and sending acceptance data in

response to the delivery list data, and a reconciliation unit

for mediating a purchase transaction between the buyer and the

seller in response to receiving the purchase request data sent
from the buyer terminal, the reconciliation unit comprising
communication circuitry for communicating with the buyer
terminal and the seller terminal and a processing system
responsive to the purchase request data for sending credit data
to the seller terminal and for sending the payment data to the
seller terminal after the product or service is supplied from
the seller,]   <u>the seller terminal comprising</u>:

communication circuitry for communicating with the buyer
terminal and the reconciliation unit; (see Fig. 3, communication
port 340 and Modem 350)and

a processing system for receiving the credit data and the
payment data from the reconciliation unit.
(central processing unit 305 and connected elements show in
Fig. 3).

Conclusion

Applicant's amendment necessitated the new ground(s) of
rejection presented in this Office action. Accordingly, **THIS
ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is
reminded of the extension of time policy as set forth in 37
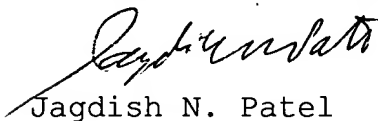CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jagdish N. Patel
(Primary Examiner, AU 3624)
11/28/04